

Application No. 10/020,786
Amendment dated September 20, 2004
Reply to Office Action of May 18, 2004

REMARKS

Applicants respectfully request entry of the Amendment and the reconsideration of the rejection of the claims.

Claims 28-41 are cancelled without prejudice or disclaimer. These claims were cancelled due to a restriction requirement. Applicants reserve the right to pursue the subject matter of these claims in one or more continuation applications.

Claims 1, 8 and 16 have been amended. Applicants submit that the amendment is supported throughout the specification, including at page 10, lines 23-27.

A. Priority

The specification has been amended to add a statement regarding the priority claim. Thus, specific reference to the prior application is now in the first sentence of the specification.

Applicants direct the Examiner's attention to MPEP 201.11 III D, which states:

"If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g. if the claim is included in the oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78 (a), the Office will not require a petition under 37 CFR 1.78 (a) or surcharge under 37 CFR 1.17 (t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt."

Applicants submit that the claim for priority was made both in the transmittal papers and an unsigned declaration at the time of filing the application. The Office recognized the claim for priority on the filing receipt. Thus, in accord with MPEP 201.11 III D, Applicants have not submitted a petition and fee indicating the delay in complying with the rules regarding the priority claim was unintentional. Applicants submit they have properly complied with the requirements to establish priority to U.S. Serial No. 60/ 256,164 filed December 14, 2000, and request that the Examiner acknowledge the claim for priority.

B. Information Disclosure Statement

Applicants submitted an Information Disclosure Statement on April 23, 2004. Applicants request that the Examiner consider the references cited therein and return the initialed 1449 form.

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C. Rejection under 35 U.S.C. §112, second paragraph

The Examiner rejects claims 1-27 under 35 U.S.C. §112, second paragraph, as indefinite. The Examiner asserts that the use of "immunoglobulin" in claims 1 and 16 renders the claims unclear. Applicants respectfully traverse the rejection.

Applicants submit that one of skill in the art reading the specification would understand the term "immunoglobulin". While not acquiescing in the rejection and solely in order to expedite prosecution, Applicants have amended claims 1, 8 and 16.

Claim 1 has been amended to recite "encoding an intact antibody" and "a biologically active intact antibody." Claim 8 has been amended to recite "expressing an intact antibody". Claim 16 has been amended to recite "producing a biologically active intact antibody" and "assembled to form a biologically active intact antibody and recovering said intact antibody".

Claims 1, 8, and 16 have been amended to provide greater clarity. The term "intact antibody" is defined in the specification at page 10, lines 23-27. In view of these amendments, Applicants respectfully request reconsideration and removal of the rejection under 35 U.S.C. §112, second paragraph.

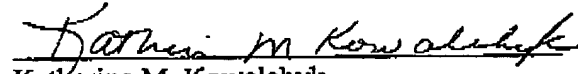
CONCLUSION

In view of the foregoing, Applicants believe that all claims as currently pending are in condition for allowance and such action is respectfully requested. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

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Katherine M. Kowalchuk
Reg. No. 36,848
KMK:BRD:sab

